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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,269	11/13/2001	Steven Gutteridge	BB1446 US NA	8085
23906	7590	12/31/2003	EXAMINER	
E I DU PONT DE NEMOURS AND COMPANY			BUI, PHUONG T	
LEGAL PATENT RECORDS CENTER			ART UNIT	
BARLEY MILL PLAZA 25/1128			PAPER NUMBER	
4417 LANCASTER PIKE			1638	
WILMINGTON, DE 19805			DATE MAILED: 12/31/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

## Office Action Summary

SM

### Application No.

10/033,269

### Applicant(s)

GUTTERIDGE ET AL.

### Examiner

Phuong T. Bui

### Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ .                      6) ☐ Other: \_\_\_\_ .

### **DETAILED ACTION**

1. The Office acknowledges the receipt of Applicant's restriction election filed November 6, 2003. Applicant elects Group I and Invention D (SEQ ID NO:8 encoding SEQ ID NO:9) without traverse. Claims 1-12 and 14-19 are pending. Claims 14-19 are withdrawn from consideration. Claims 1-12 are examined in the instant application. This restriction is made FINAL.

#### ***Sequence Listing***

2. Applicant's CRF and paper sequence listing have been entered. However, upon examination of SEQ ID NO:8 and its corresponding amino acid sequence SEQ ID NO:9, it is unclear what region of SEQ ID NO:8 encodes SEQ ID NO:9. Clarification is required.

#### ***Information Disclosure Statement***

3. An initialed and dated copy of Applicant's IDS form 1449, filed February 19, 2002 is attached to the instant Office action.

#### ***Specification***

4. The Brief Description of Drawings in the specification does not match the drawings submitted. Figures 1A and 1B are not described in the specification. Correction is required.

#### ***Claim Rejections - 35 USC § 112, first paragraph***

5. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description** requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims reciting 85-95% sequence identity lack adequate written

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description because Applicant does not disclose a representative number of species as encompassed by these claims. The claims encompass mutants and allelic variants and thus imply that structural variants exist in nature, yet no structural variant has been disclosed. The claims also encompass pantothenate synthetases from other species. The implication is that there is a gene and a protein other than that disclosed which exists in nature, but the structure thereof is not known. Applicant discloses a single sequence SEQ ID NO:8 isolated from soybean. Thus, there is insufficient relevant identifying characteristics to allow one skilled in the art to predictably determine such mutants, allelic variants and pantothenate synthetases from other plants and organisms, absent further guidance. Accordingly, there is lack of adequate description to inform a skilled artisan that applicant was in possession of the claimed invention at the time of filing. See Written Description guidelines published in Federal Register/ Vol.66, No. 4/ Friday, January 5, 2001/ Notices; p. 1099-1111.

6. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:8 and a nucleic acid sequence encoding SEQ ID NO:9, does not reasonably provide enablement for nucleic acid sequences having 85-95% sequence identity to SEQ ID NO:9 at the amino acid level. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The breadth of the claims encompasses sequences having unspecified deletions, additions, substitutions and combinations thereof while maintaining pantothenate synthetase activity. Neither the state of the prior art nor Applicant provided guidance as to which regions of SEQ ID NO:8 or a sequence encoding SEQ ID NO:9 must be retained for activity, and which regions can tolerate mutations. Applicant

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provided no working examples of sequences having 85-95% sequence identity. While one skilled in the art can readily make mutations to SEQ ID NO:8 or a sequence encoding SEQ ID NO:9, further guidance is required as to which mutations would be tolerated. Absent of such guidance, one skilled in the art cannot make and use the claimed invention as commensurate in scope with the claims without undue experimentation.

***Remarks***

7. Claims 4-5 are objected to as being dependent on a rejected claim but would be allowable if rewritten in independent form. SEQ ID NO:8 encoding SEQ ID NO:9 is free of the prior art. It is understood by the Office the recited Clustal alignment method uses the default parameters set forth on page 24 of the specification. The closest prior art teaches a sequence from *Lotus japonicus* having 78.6% sequence identity with SEQ ID NO:9 (WO 99/42565 (Applicant's IDS)).

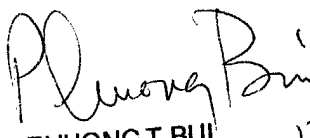
8. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
December 26, 2003

  
PHUONG T. BUI  
PRIMARY EXAMINER  
12/26/03